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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/15/2003

Isaac D. Cohen

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EXAMINER

HUI, SAN MING R

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/713,843	COHEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	San-ming Hui	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/17/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-24 are pending.

Claims 8-9 and 15-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 24, 2007.

Applicant's amendments filed December 20, 2007 have been entered.

Applicant's remarks with regard to the non-elected subject matter in claims 8-9 and 15-24 have been considered, but are not found persuasive. In the response to the election requirements filed April 24, 2007, the applicant elects glass beads and further states that claims 1-14 read on the elected specie glass beads [examiner notes: not glass spheres] (See pages 1, last paragraph and page 2, second paragraph). Since claims 15-24 are directed to non-elected specie, glass spheres, the claims are remained withdrawn as directed to non-elected specie.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,830,485 ('485) and EP 1 013 724 ('724), references of record in view of JP 2184618, English abstract is also provided.

'485 teaches a colored cosmetic composition comprising filler and colorant (pigments) (see claim 1). '485 teaches that particle size of the filler as 0.8 – 180  $\mu\text{m}$  (see claim 1). Depending on the cosmetic formulations, the particle size can be less than 20 $\mu\text{m}$  (See for example, Examples 1 and 3 in the specification). '485 teaches one of the fillers as glass beads (see claim 1). '485 also teaches the particle size of the pigments (colorants) as 0.1 – 25  $\mu\text{m}$  (See col. 3, line 2).

'724 teaches a pigment mixtures comprising titanium oxide coated alumina ( $\text{Al}_2\text{O}_3$ ) and bismuth oxychloride ( $\text{BiOCl}$ ) (See paragraph [0019]) with improved hiding power (see paragraph [0002]).

The references do not expressly teach the pigments taught in '724 be incorporated into the cosmetic composition of '485. The references do not expressly teach the herein recited particle size and amount. The references do not expressly teach the glass beads to have a light transmission value of greater than 70%.

JP 2184618 teaches that glass beads in the cosmetic composition have at least 85% of light transmission (see the English abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the pigments taught in '724 into the cosmetic composition of '485. It would have been obvious to one of ordinary skill in the art at the time of invention to adjust the amount and particle size of the herein components. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the glass materials with light transmission of at least 85% in the cosmetics.

One of ordinary skill in the art would have been motivated to incorporate the pigments taught in '724 into the cosmetic composition of '485 since incorporating the pigments taught in '724 into the cosmetic composition of '485 would improve the hiding power of the colored cosmetic composition of '485. Furthermore, one of ordinary skill in the art would have been motivated to adjust the particle size and amount of the herein claimed components since optimization of the result parameters is obvious as being within the purview of skilled artisan. In addition, one of ordinary skill in the art would have been motivated to use the glass materials with light transmission of at least 85% in the cosmetics since according to JP2184618, the glass balls can be useful for protecting skin from UV light radiation.

### ***Response to Arguments***

Applicant's arguments filed December 20, 2007 averring the cosmetic composition suggested by the cited prior art not being a simple combination have been fully considered but they are not persuasive. The examiner notes that it is not really clear what is simple combination and what is not. The examiner interprets the term "simple combination" to be any combination can be routinely done by one of ordinary skill in the art. In the instant case, the prior art teaches ordinary ways to make or prepare the herein claimed components and put them together. Therefore, possessing the teachings of the cited prior art, one of ordinary skill in the art would have been motivated to incorporate the herein claimed components into the resulting cosmetics composition with improved hiding power.

Applicant's arguments filed December 20, 2007 with regard to the teaching away of '485 have been considered, but are not found persuasive. '485 merely teaches that only certain colorants are known to have safety issues. It would be obvious to one of ordinary skill in the art to employ the colorants which are safe to use in the resulting cosmetics composition. Furthermore, '485 has already provided a way to solve the problem of the potential toxicity from the colorant. Therefore, possessing the teachings of the cited prior art, one of ordinary skill in the art would have been motivated to incorporate the herein claimed components into the resulting cosmetics composition with improved hiding power.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (571) 272-0626. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

San-ming Hui  
Primary Examiner  
Art Unit 1617

/San-ming Hui/  
Primary Examiner, Art Unit 1617